



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,097	07/25/2003	Michael John Martin	13869.33	2250

22913 7590 01/25/2005

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &
SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER

LE, TAN


ART UNIT

PAPER NUMBER

3632

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No.	Applicant(s)	
	10/627,097	MARTIN ET AL.	
	Examiner	Art Unit	
	Tan Le	3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the first office action for application serial number 10/627,097. This application contains claims numbered 8-16. Claims 1-7 have been canceled.
2. Applicant's election without traverse of invention Group I, claims 8-16, filed on 10/13/04 is acknowledged.

Claims 1-7 have been canceled, therefore no claims are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
4. IDS submitted on 5/21/04 has been reviewed and considered.
5. The use of the trademark "Chevrolet" or "Chemlok 213/219" (Pages 5-6) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

It should also be noted that the use of TDI or MDI through out the specification but does not explain what it stands for. Description for such abbreviation is required.

Beginning of page 1, "THIS INVENTION" should also be changed to --This invention--.

Art Unit: 3632

6. Claims 8 and 10 recite "MD1" appears to be incorrect. It should be changed to -- MDI--.

Claim 13 recites "the range". It should be changed to -- a range --.

Drawings

7. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "a cushion material 6 cast there between (brackets)" as described on page 5 of the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites a "cured MDI polyurethane cushioning material" but the specification does not describe what a cured "MDI" is. It is unclear as to what a cured MDI that Applicants are intended to claim, rendered the claims indefinite.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, Applicants are claiming a "cured MDI..." but does not describe in the specification as originally filed.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3632

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 5,788,207 to Bunker.

Bunker discloses an automobile transmission mount comprising space metal mounting brackets (12, 34), each mounting bracket being adhesively anchored to a polyurethane cushioning material cast there between.

Bunker discloses substantially as claimed except for the brackets having a bright corrosion metal finish.

It would have been obvious matter of design choice to have polished the metal brackets to obtain a bright metallic finish to enhance their appearance as well as to provide users with a convenient alternative choice, since such coating are conventional alternative used in the same intended purpose thereby providing structure as claimed.

It should be also be noted that claim 1 recites "a cured... polyurethane cushioning material", although this claim is unclear as to what a cured MDI process means; however, this claim appears to be a product -by- process claim. A product-by-process claim is not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 f2d 67, 190 USPQ 15, CCPA 1976).

Claims 9-12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bunker in view of US Patent no. 5,325,776 to Rather, Sr. et al.

Regarding claims 9-12, Bunker discloses the claimed invention as discussed above except the polyurethane cushioning material being at least partially cross-linked and the polyurethane cushioning material comprised of a polyester based, MDI terminated prepolymer reacted with a low molecular weight polyol, wherein said low molecular weight polyol is an aliphatic diol.

Rather, Sr. et al discloses an improved polyurethane cushioning material, which is at least partially cross-linked (the preferred material being formed from a blend of filler particles that includes comminuted elastomer particles and is preferably formed of a resilient cross-linked elastomer to make a matrix of polyurethane material that can be cured into a sheet material using a catalyst) and the polyurethane cushioning material comprised of a polyester polyols based reacted with a low molecular weight aliphatic diols, which forms pneumatically compressible pockets believed to be critical to providing the improved performance of the materials in a recovering rapidly from compressive forces. Therefore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to use elastomeric cushioning material of Bunker in view of the recognition of Rather, Sr. et al. that improved the performance of the material would be expected.

Regarding claim 16, the polyurethane material of Bunker in view of Rather, Sr. et appears to be coloured.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bunker in view of Rather, Sr. et al. and further in view of US Patent No. 5,915,495 to Kerlin et al.

Unlike Bunker in view of Rather, Sr, Kerlin et al. discloses an isolator (166, 168) which preferably are formed from a resilient material such as polyurethane elastomer, preferably having a hardness value of from about 50 Shore A to about 70 Shore A.

It would have been obvious to one having ordinary skilled in the art at the time the invention was made to have provided a cured polyurethane cushioning material having a Shore hardness in the ranges as claimed in claims 13-15 since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routines skill in the art. In *Re Aller*, 105 USPQ 233. Nevertheless, to have selected hardness in the ranges a claimed is considered an obvious matter of design choice since it depends on the desired material, the thickness and the degree of flexibility (cushion) to be selected.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 2004/0159767 to Martin et al.

4,989,665 to Yamagiwa et al.

3,878,133 to Rubens


3,616,159 to Kamp.

The above patents disclose various types of resilient mountings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (703) 305-8244. The examiner can normally be reached on Mon. through Fri. from 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
Patent examiner
January 18, 2005